

**REMARKS**

This Application has been reviewed carefully in light of the Office Action mailed December 1, 2003. Claims 1-51 were pending in the Application and stand rejected. Applicants amend Claims 1, 7, 14-16, 19, 20, 24-31, 33, 39, 41, 46, 47, and 51 and add new Claims 52 and 53. Applicants respectfully request reconsideration and favorable action in this case.

**Rejections - 35 U.S.C. §112, second paragraph**

The Examiner rejects Claims 26, 28 and 29 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend these claims to depend from Claim 25 as was originally intended.

**Rejections - 35 U.S.C. §102**

The Examiner rejects Claims 1-3, 6-8, 10, 12, 14, 15, 17-21, 24, 26-29, 33-37, 41, 42, 44-48, 50, and 51 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,946,634, which issued to Korpela ("*Korpela*"). To anticipate a claim, a single prior art reference must describe, either expressly or inherently, each and every element of the claim. M.P.E.P. §2131.

Applicants' Claim 1, as amended, recites:

A configurable telecommunications system, comprising:

an interface device having a plurality of telephony resources and operable to maintain a local protocol database comprising a plurality of protocol modules, to identify, for each of the telephony resources, a protocol module required to process signals received by the telephony resource, to determine, for each of the identified protocol modules, whether the identified protocol module is valid in the local protocol database, to request each of the protocol modules not determined valid from a system controller, to receive the requested protocol modules from the system controller, and to store the requested protocol modules in the local protocol database; and

the system controller operable to maintain a system protocol database storing a plurality of master protocol

modules, to receive requests from the interface device requesting selected ones of the master protocol modules, and to communicate the requested master protocol modules from the system protocol database to the interface device.

Applicants respectfully submit that *Korpela* fails to disclose every element of this Claim. *Korpela* discloses an end user device, a mobile phone, that can be updated to handle communications when moving to new radio access networks.

Among other aspects of Claim 1, *Korpela* fails to disclose

an interface device having a plurality of telephony resources and operable to maintain a local protocol database comprising a plurality of protocol modules, to identify, for each of the telephony resources, a protocol module required to process signals received by the telephony resource, to determine, for each of the identified protocol modules, whether the identified protocol module is valid in the local protocol database, to request each of the protocol modules not determined valid from a system controller.

Therefore, *Korpela* fails to anticipate Claim 1.

The reasons discussed above with respect to independent Claim 1 apply similarly with respect to Applicants' remaining independent Claims 7, 14, 20, 25, 33, 41, and 47. Claims 2, 3, 6, 8, 10, 12, 15, 17-19, 21, 24, 26-29, 34-37, 42, 44-46, 48, 50, and 51 depend from various of these independent claims. Therefore, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-3, 6-8, 10, 12, 14, 15, 17-21, 24, 26-29, 33-37, 41, 42, 44-48, 50, and 51.

### **Rejections Under U.S.C. §103**

The Examiner rejects Claims 4, 5, 9, 11, 13, 16, 22, 23, 25, 30-32, 38-40, 43, and 49 under 35 U.S.C. §103(a) as being unpatentable over *Korpela* in view of U.S. Patent No. 6,426,963, which issued to Kim ("*Kim*"). To establish obviousness of a claimed invention under §103, all claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03.

Applicants' independent Claim 25, as amended, recites:

A method for processing a telephony signal, comprising:  
maintaining a local protocol database comprising a plurality of protocol modules;  
identifying, for each of a plurality of telephony resources, a protocol module required to process signals received by the resource;  
determining, for each of the identified protocol modules, whether the identified protocol module is valid in the local protocol database;  
requesting each of the protocol modules not determined valid from a remote protocol database;  
receiving the requested protocol modules from the remote protocol database;  
storing the requested protocol modules in the local protocol database;  
receiving the signal from one of the telephony resources;  
determining a signal type for the signal using a core signal handler;  
accessing resource information associated with the resource to determine a current state of the telephony resource;  
selecting one of the protocol modules for processing the signal; and  
processing the signal using the selected protocol module based on the signal type and the current state.

Applicants respectfully submit that *Korpela* taken alone or in combination with *Kim* fails to teach or suggest all elements of Claim 25.

For analogous reasons as discussed above with regard to Claim 1, Applicants respectfully submit that *Korpela* fails to disclose at least the following elements of Claim 25:

identifying, for each of a plurality of telephony resources, a protocol module required to process signals received by the resource;  
determining, for each of the identified protocol modules, whether the identified protocol module is valid in the local protocol database;  
requesting each of the protocol modules not determined valid from a remote protocol database;

Furthermore, the introduction of *Kim* fails to provide the elements of Applicants' Claim 25 not shown by *Korpela*.

The reasons discussed above with respect to independent Claim 25 apply similarly with respect to Applicants' remaining independent Claims 1, 7, 14, 20, 33, 41, and 47. Claims 4, 5, 9, 11, 13, 16, 22, 23, 30-32, 38-40, 43, and 49 depend from various of these independent claims. Therefore, for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 4, 5, 9, 11, 13, 16, 22, 23, 25, 30-32, 38-40, 43, and 49.

Additionally, Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Korpela* and *Kim* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." M.P.E.P. §2143.01. "The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *Id.* Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. Furthermore, nothing in *Korpela* or *Kim* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests the proposed combination. Speculation in hindsight that it would have been obvious to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.<sup>1</sup> and governing Federal Circuit case law.<sup>2</sup>

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<sup>1</sup> See M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.")

<sup>2</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the

**CONCLUSION**

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants enclose a check for \$36.00 to cover the cost of filing two (2) additional dependent claims. The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

*Id.* at 999 (emphasis added) (citations omitted).